

### REMARKS

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-18 are pending in this application.

#### Double Patenting Rejection

Claims 1-18 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-4, 12, 31, and 32 of U.S. Patent No. 6,444,786. A terminal disclaimer in compliance with 37 CFR 1.321(b)(iv) is enclosed herewith to overcome this rejection.

Claims 1-4, 6, 8, 9, 12-18 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 3, 6, 8, 9, 11-13, and 17-22 of U.S. Patent No. 6,620,781. A terminal disclaimer in compliance with 37 CFR 1.321(b)(iv) is enclosed herewith to overcome this rejection.

#### §102 Rejection of the Claims

Claims 1-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Judice et al. U.S. 6,444,786 and also Judice et al. U.S. 6,392,012. These rejections are respectfully traversed.

The cited patents (the Judice '786 and '012 patents) each report a large genus of glycopeptides wherein the C-terminus is substituted with a broad group of substituents (see the claims of the '786 and '012 patents discussed in the Office Action). Applicant's claims are directed to glycopeptides "substituted at the C-terminus with a substituent that comprises two or more carboxy groups" (claim 1).

Applicant respectfully points out that the instant claims do not include any of the specific compounds prepared in the '786 and '012 patents (see the instant specification at page 3, line 16, bridging to page 5, line 16). The proviso in claim 1 specifically excludes the glycopeptides prepared in U.S. Patent Application Serial Number 09/470,209, which matured into the cited patents. Thus, the instant claims do not include any of the compounds specifically prepared in the cited patents.

Additionally, in order to anticipate a claimed compound, a reference must clearly convey to one skilled in the art the information that the particular compound has been invented. *In re*

*Schaumann* 197 U.S.P.Q. 5 at 8. A generic formula which encompasses a vast number of compounds does not describe, and thus does not anticipate, all compounds embraced therein, merely because they are within the scope of the formula. *In re Petering et al.* 133 U.S.P.Q. 275.

It is respectfully submitted that the cited patents do not provide any guidance that would cause one skilled in the art to select from the broad definitions of R<sup>3</sup> and R<sup>22</sup> therein, in the manner required to arrive at the presently claimed compounds. Thus, the references do not clearly convey to one skilled in the art that any of the instantly claimed compounds have been invented. See *In re Schaumann* 197 U.S.P.Q. 5 at 8. Accordingly, the instant claims are not anticipated by the generic disclosures in the cited patents.

Because the instant claims do not include any of the compounds specifically prepared in the cited patents, and because the generic disclosures of the cited patents do not specifically describe any of the claimed compounds to the extent required to anticipate the instant claims, withdrawal of the rejections under 35 U.S.C. §102 is appropriate and is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3265 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

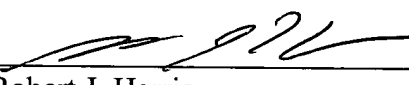
Respectfully submitted,

MARTIN S. LINSELL ET AL.

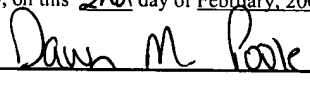
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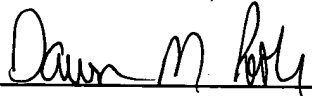
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Date 2-2-04

By   
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Reg. No. 37,346

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 2nd day of February, 2004.

  
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